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10/621,754	07/18/2003	John Chuang	Chuang 0001P	1725

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EXAMINER

GRAHAM, ANDREW R

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,754

Applicant(s)

CHUANG, JOHN

Examiner

Andrew Graham

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/18/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 2644

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because they fail to meet several of the requirements of 37 CFR 1.84, including subsections (g), (l), and (p) . Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-15** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 2644

Claims 1, 8, and 13 each recite components being "sewn into" fabric material. However, the disclosure does not further specify the manner in which such sewing is performed, only repeating that such components are "sewn into" the fabric (for example, page 5, lines 13-18). Specifically, the physical relationship between the fabric, the digital components, and the implicit stitches of the sewing is not described in the specification. Figure 2B suggests the use of an item, possibly fabric, surrounding the module, but does not illustrate any suggestion of sewing or stitches. Basic manners of sewing are known in the art, but less is known in the prior art regarding the nature of sewing a physical object "into" a fabric. As such, without direction being provided by the specification as how to make a device that meets such a limitation, the evidence as a whole leads to the conclusion that the specification fails to teach how to make and use the claimed invention without undue experimentation.

Claims 2-7, 9-12, and 14-15 depend upon Claims 1, 8, and 13 and are rejected at least for the same reasons listed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2644

3. **Claims 1 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudoy (USPN 6568828 B2) in view of Pascal (US 2002/0100103 A1).

Rudoy discloses a packaging for gift wrapping comprising light and audio components embedded, intertwined, or otherwise incorporated into the packaging.

Regarding **Claim 1**, Rudoy discloses:

An article of manufacture ("packaging material", col. 2, lines 66-67) comprising:

a fabric material (10) ("nylon, cloth, other conventional material commonly used to make ribbons") (col. 2, lines 66-67; col. 3, lines 1-2); and

a digital module ("computer chip") coupled ("embedded") to the fabric material (10) (col. 3, lines 58-65)

While Rudoy teaches that the chip and related components may be embedded in the ribbon and that leads of related components may be otherwise be concealed in the ribbon, Rudoy does not clearly specify:

- wherein the digital module is sewn into a portion of the fabric material

Pascal discloses a maternity wear garment comprising speakers and a controller module that, in one embodiment, may comprise sound generation means.

Specifically regarding **Claim 1**, Pascal teaches:

Art Unit: 2644

wherein the digital module (42) is sewn into a portion of the fabric material (by 54) (42 may contain chip comprising prerecorded sounds, 0049; 54 is sewn, may encompass part or entire item 22 to which it is sewn, enclosing sound generating elements, such as 42 as suggested by Figure 3, therein, 0036-0037)

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to embed at least the computer chip of Rudoy using a sewn cover panel over part or the entirety of the ribbon, as is taught by Pascal. The motivation behind such a modification would have been that sewing is a secure method of attachment, and such a sewn panel would have prevented the back of the computer chip from being viewed, making the ribbon more aesthetically pleasing to look at. Such a sewn cover panel or enclosure would have also provided protection to the computer chip.

Regarding **Claim 3**, Rudoy discloses:

the fabric material comprises a ribbon-type material (10) (col. 3, lines 1-2 and 62-65; Figure 3)

4. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudoy in view of Pascal as applied above, and in further view of Petty (USPN 5367752).

Rudoy discloses a packaging for gift wrapping comprising light and audio components embedded, intertwined, or otherwise incorporated into the packaging. Pascal discloses a maternity wear garment

Art Unit: 2644

comprising speakers and a controller module that, in one embodiment, may comprise sound generation means.

Regarding the material of the ribbon, Rudoy teaches that a nylon, cloth, or other conventional material commonly used for making ribbons may be employed (col. 2, lines 66-67; col. 3, lines 1-2).

However, Rudoy in view of Pascal does not clearly teach:

- the fabric material comprises a polyester-type material

However, polyester type materials are known in the art to be used in the making of ribbons, as is evidenced by the teachings of Petty. Petty teaches an expandable wrapping ribbon that may be weaved from fine cotton, linen, or polyester strands (col. 4, lines 21-25). The use of polyester strands in the making of a ribbon reads on "the fabric material comprises a polyester-type material".

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to weave the fabric material in the system of Rudoy in view of Pascal out of polyester threads, as is taught for the ribbon of Petty. The motivation behind such a modification would have been that such woven polyester would have characterized the ribbon with a fine quality used in ornamentation.

5. **Claims 4-8 and 10-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudoy in view of Pascal as applied above, and in further view of McNeese et al (US 20020105431 A1), hereafter "McNeese".

Art Unit: 2644

As detailed above, Rudoy discloses a packaging for gift wrapping comprising light and audio components embedded, intertwined, or otherwise incorporated into the packaging. Pascal discloses a maternity wear garment comprising speakers and a controller module that, in one embodiment, may comprise sound generation means.

Regarding the operation of the sound generating means, Rudoy teaches that a switch for a box embodiment of sound generating means that involves detecting the open state of the box (col. 4, lines 52-62). Pascal teaches that the controller (42) includes a selector (50) and Figures 1, 2, and 3 illustrate the controller (42) positioned behind the front cover (54) with the selector exposed (0027,0031,0037).

However, Rudoy in view of Pascal does not clearly specify:

an activation mechanism coupled to the digital module wherein the activation mechanism is sewn into the fabric material

McNeese teaches an audio playback module to be utilized with gift packaging.

Specifically regarding Claim 4, McNeese teaches:

an activation mechanism (24) coupled to the digital module (34) (0018,0019, Figure 8)

wherein the activation mechanism (24) is sewn into the fabric material (44 on circuit board 34 with voice chip, para. 0019, in view of controller 42 sewn into layers of fabric of Pascal)

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to incorporate the on/off/record

Art Unit: 2644

switch, as well as the associated voice recording circuitry of McNeese as part of the sound generating devices sewn into the ribbon of Rudoy in view of Pascal. The motivation behind such a modification would have been that such a tri-state switch and voice circuitry would have enabled a personalized audio message to be selectively recorded for a gift recipient, while conditionally enabling such playback of the message, such as when the gift has been placed a desired location.

Regarding **Claim 5**, McNeese particularly discloses:

the digital module (34) includes a voice recording feature whereby a voice message can be recorded ("digitizing and storing audible sounds for playback", para. 0019).

Regarding **Claim 6**, McNeese particularly discloses:

wherein the activation mechanism (24) activates the digital module (34) ("on" position of 24, para. 0019)

Regarding **Claim 7**, McNeese particularly discloses:

wherein the activation mechanism (24) activates the voice recording feature ("record" position of 24, para. 0019)

Regarding **Claim 8**, Rudoy in view of Pascal and McNeese discloses:

A packaging ribbon (10 of Rudoy, col. 2, lines 66-67) comprising:
a fabric material (col. 2, lines 66-67 and col. 3, line 1 of Rudoy)

a digital module ("computer chip") coupled ("embedded") to the fabric material (col. 3, lines 58-65 of Rudoy); and

an activation mechanism (24) coupled to the digital module (34) (para. 0019 of McNeese)

Art Unit: 2644

wherein the digital module (42 of Pascal in view of chips of Rudoy and 34 of McNeese) and the activation mechanism (50 of Pascal in view of 24 of McNeese) are sewn ("sewn or otherwise securely coupled") into a portion of the fabric material (cover 54 of Pascal is for part or entire garment) (para. 0027, 0031, 0036-0037, 0049 of Pascal).

Regarding **Claim 10**, please refer above to the rejection of the similar limitations of Claim 5.

Regarding **Claim 11**, please refer above to the rejection of the similar limitations of Claim 6.

Regarding **Claim 12**, please refer above to the rejection of the similar limitations of Claim 7.

Regarding **Claim 13**, Rudoy in view of Pascal and McNeese discloses:

A packaging ribbon (10 of Rudoy, col. 2, lines 66-67) comprising:
a fabric material (col. 2, lines 66-67 and col. 3, line 1 of Rudoy)

a printed circuit board ("printed circuit board" with voice chip of McNeese, para. 0018, in view of "computer chip" of Rudoy, col. 3, lines 58-65);

a speaker (32 of McNeese in view of "small speakers" of Rudoy and 48 of Pascal) coupled to the printed circuit board (34) (Figure 8, para. 0018 of McNeese)

at least one activation mechanism (24, 44) coupled to the printed circuit board (34) and the speaker (32) (para. 0019 of McNeese)

Art Unit: 2644

wherein the printed circuit board (34) (in view of chips of Rudoy and 42 of Pascal) and the speaker (32 of McNeese in view of "small speakers" of Rudoy and 48 of Pascal) are sewn ("sewn or otherwise securely coupled) into the fabric material (cover 54 of Pascal is for part or entire garment) (para. 0027, 0031, 0036-0037, 0049 of Pascal).

Regarding **Claim 14**, McNeese particularly discloses:

wherein the at least one activation mechanism (24, 44) comprises a record button ("record position" of 24, para. 0019).

The playback switch (44) of McNeese is motion activated (para. 0019). However, Pascal teaches a push-button type as another form of switch (0028). To one of ordinary skill in the art at the time the invention was made, it would have been obvious to substitute a push-button or pressure-based switch, such as the push-button contact switch taught by Pascal for the motion activated playback switch of McNeese because pressure and motion switches are art-recognized equivalents for the same purpose, per MPEP 2144.06. This equivalency is evidenced in prior art reference DeCicco (USPN 6020823), which states that switches activated by physical pressure or motion may both be used to activate a sound chip (col. 4, lines 2-8).

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudoy in view of Pascal and McNeese as applied above, and in further view of Petty (USPN 5367752).

Rudoy discloses a packaging for gift wrapping comprising light and audio components embedded, intertwined, or otherwise incorporated

Art Unit: 2644

into the packaging. Pascal discloses a maternity wear garment comprising speakers and a controller module that, in one embodiment, may comprise sound generation means. McNeese teaches an audio playback module to be utilized with gift packaging, wherein the module comprises a tristate switch and voice recording functions.

Regarding the material of the ribbon, Rudoy teaches that a nylon, cloth, or other conventional material commonly used for making ribbons may be employed (col. 2, lines 66-67; col. 3, lines 1-2).

However, Rudoy in view of Pascal and McNeese does not clearly teach:

- the fabric material comprises a polyester-type material

However, polyester type materials are known in the art to be used in the making of ribbons, as is evidenced by the teachings of Petty. Petty teaches an expandable wrapping ribbon that may be weaved from fine cotton, linen, or polyester strands (col. 4, lines 21-25). The use of polyester strands in the making of a ribbon reads on "the fabric material comprises a polyester-type material".

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to weave the fabric material in the system of Rudoy in view of Pascal and McNeese out of polyester threads, as is taught for the ribbon of Petty. The motivation behind such a modification would have been that such woven polyester would have characterized the ribbon with a fine quality used in ornamentation.

Art Unit: 2644

7. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudoy in view of Pascal and McNeese as applied above, and in further view of Fry (USPN 4862438).

Rudoy discloses a packaging for gift wrapping comprising light and audio components embedded, intertwined, or otherwise incorporated into the packaging. Pascal discloses a maternity wear garment comprising speakers and a controller module that, in one embodiment, may comprise sound generation means. McNeese teaches an audio playback module to be utilized with gift packaging, wherein the module comprises a tristate switch and voice recording functions.

Regarding **Claim 15**, McNeese particularly teaches the inclusion of playback and record buttons (42,24) in the context of a voice recorder to be associated with a gift, while Rudoy (18) and Pascal (50) both discuss switches associated with audio playback devices.

However, Rudoy in view of Pascal and McNeese do not clearly specify:

- the play button and the record button are coupled to the printed circuit board via a plurality of connection wires.

Fry discloses a system comprising an audio recorder (18) contained in a fabric casing (12).

Regarding **Claim 15**, Fry discloses:

the play button and the record button (50,52 in view of separate function, multiple buttons of McNeese 24,42) are coupled to the printed circuit board (26 in view of 34 of McNeese) via a plurality of connection wires (54).

Art Unit: 2644

To one of ordinary skill in the art at the time the invention was made, it would have been obvious to individually connect the playback and record switches of the system of Rudoy in view of Pascal and McNeese by wires, such as taught for control switches in the system of Fry. The motivation behind such a modification would have been that such wires would have enabled the control switches to be located remotely from the recorder components, such as in the corners of the ribbons.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Graham whose telephone number is 571-272-7517. The examiner can normally be reached on Monday-Friday, 8:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SINH TRAN
SUPERVISORY PATENT EXAMINER

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June 6, 2005